

REMARKS

The Official Action mailed August 19, 2004, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on January 12, 2000, March 31, 2000, June 28, 2001, October 31, 2001, December 26, 2002, August 27, 2003, January 6, 2004, and July 22, 2004.

Although the Applicants previously stated that the IDS filed July 1, 2002, was fully considered, upon further review it appears that the IDS filed on July 1, 2002, was only partially considered. Specifically, as shown in the attached copy of the 1449 signed September 19, 2002, it appears that the Examiner inadvertently overlooked the citation of the "European Search Report dated June 4, 2002." The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced information.

It is also noted that "Duplicate" has been written across the signed 1449 near the citation of JP 03-226392. It is believed that this has been written by Office personnel to indicate a duplicate copy of the 1449 in the patent application file and that "Duplicate" does not refer to JP '392, which was first cited in the present application in the IDS filed July 1, 2002.

Claims 1-37 are pending in the present application, of which claims 1-3, 7, 10 and 13 are independent. Independent claims 3 and 13 have been amended to better recite the features of the present invention. The Applicant notes with appreciation the allowance of claims 1, 2, 4, 5, 7-12, 17-23 and 27-34 (page 2, Paper No. 20040816). For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 3, 6, 13-16, 24, 25, 35 and 36 as anticipated by U.S. Patent No. 6,323,937 to Sano. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicants respectfully submit that an anticipation rejection cannot be maintained against independent claims 3 and 13 of the present application, as amended. Sano does not teach all the elements of independent claims 3 and 13, either explicitly or inherently.

The Official Action asserts that Figure 4 in Sano "illustrates a laser system having a laser source (1), a cylindrical lens group (3b) and (3c) for dividing the laser beam, a condenser optical system (4) which overlaps the divided laser beams and a slit (9) for shaping the laser beam, as described in column 4 line 40 to column 5 line 42" and the "shape of the laser beam formed by the slit is illustrated in figure 4 as the light intensity distribution, which is shown as having edges" (page 3, Paper No. 20040816). Independent claims 3 and 13 have been amended to add the feature that the slit is located between the beam generating unit and the cylindrical lens group. In the present invention, since the emitted laser beam is modified so as to make the edge of the beam into straight lines before division by the cylindrical lens group and overlapping by the optical system, the laser beam processed in this manner has an even energy distribution in the direction along which it is divided. On the other hand, it appears that Sano does not teach that slit 9 is located between laser light source 1 and cylindrical lenses 3b and 3c, either explicitly or inherently.

Since Sano does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly,

reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 26 and 37 as obvious based on the combination of Sano and U.S. Patent No. 6,100,961 to Shiraishi et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Shiraishi does not cure the deficiencies in Sano. The Official Action relies on Shiraishi to allegedly teach use of an excimer laser or YAG laser to provide a harmonic wave for irradiating a substrate (page 5, Paper No. 20040816). However, Sano and Shiraishi, either alone or in combination, do not teach or suggest that a slit is located between a beam generating unit and a cylindrical lens group. Since Sano and Shiraishi do not teach or suggest all the claim limitations, a *prima facie* case of obviousness

cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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STATEMENT BY APPLICANT**

(use as many sheets as necessary)

Complete if Known

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|-------|---|----|---|------------------------|------------------|
| Sheet | 1 | of | 1 | Application Number | 09/481,396 |
| | | | | Filing Date | January 12, 2000 |
| | | | | First Named Inventor | Koichiro TANAKA |
| | | | | Group Art Unit | 2877 |
| | | | | Examiner Name | A. Rodriguez |
| | | | | Attorney Docket Number | 0756-2092 |

U.S. PATENT DOCUMENTS

| Examiner Initials ¹ | Cite No. ¹ | U.S. Patent Document | | Name of Patentee or Applicant of Cited Document | Date of Publication of Cited Document MM-DD-YYYY | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|--------------------------------|-----------------------|----------------------|--------------------------------------|---|---|--|
| | | Number | Kind Code ² (if known) | | | |
| AC | | 5,798,784 | | Nonaka et al. | 08/25/98 | |
| | | 4,942,588 | | Yasui et al. | 07/17/90 | |
| | | 5,900,980 | | Yamazaki et al. | 05/04/99 | |
| | | 5,059,013 | | Jain | 10/22/91 | |
| | | 5,897,799 | | Yamazaki et al. | 04/27/99 | |
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FOREIGN PATENT DOCUMENTS

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|--------------------------------|-----------------------|-------------------------|---------------------|--------------------------------------|---|---|--|----------------|
| | | Office ⁴ | Number ⁴ | Kind Code ⁵ (if known) | | | | |
| AC | | JP | 03-226392 | | 10/07/91 | | | Abst. |

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

| Examiner Initials ¹ | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ³ |
|--------------------------------|-----------------------|---|----------------|
| | | European Search Report dated June 4, 2002 | |

| | | | |
|--------------------|-------------------|-----------------|---------|
| Examiner Signature | Armando Rodriguez | Date Considered | 9-19-02 |
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

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